REMARKS

The outstanding issues in the instant application are as follows:

- Claims 1 – 20 are rejected under 35 U.S.C. §103(a);

Applicant hereby traverses the outstanding objections and rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claims 1 – 20 are pending in this application.

I. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1 – 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent application Publication No. U.S./2002/0046041 to Lang (hereinafter *Lang*) in view of U.S. Patent No. 6,092,197 to Coueignoux (hereinafter *Coueignoux*).

According to MPEP § 2142:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure M.P.E.P. § 2142 (*citing In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)).

Applicant renews its contention that the Examiner has failed to meet his burden of proof and has, thus, failed to establish a *prima facie* case of obviousness by failing to meet at least one of the above three basic criteria.

A. Motivation to Combine the References

The Examiner acknowledges that references cannot be arbitrarily combined to support a claim rejection. Office Action p. 9. According to the M.P.E.P.:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly

> or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. M.P.E.P. § 2143.01.

The test for an implicit showing is what the combined teachings, knowledge of one or ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Without a proper motivation or suggestion to combine, a proposed combination becomes merely arbitrary, which the Examiner has already admitted is improper. The Federal Circuit, in *In re Vaeck*, has held that the motivation or suggestion must come from the prior art and not the applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). *Lang* teaches an automated system for exchanging reputation information. [0005]. The *Lang* system stores reputation information about one or more parties and provides this information to clients of the *Lang* reputation service. [0022] – [0024]. *Lang* discusses security and safeguards at length throughout the specification. For example, safeguards may be provided to ensure that the reputation information is based on valid and reliable information. [0023], [0042]. Access to certain reputation information may be restricted to ensure only authorized persons can access the reputation information. [0023], [0042]. The communicated reputation information may be encrypted for additional security. [0024], [0042].

Coueignoux teaches an information gathering system. Abstract. Users are requested to enter information into the *Coueignoux* system using interactive scripts. Col. 6. If this information is confidential or private, the user may indicate that the *Coueignoux* system is not to share or publish that private information. Col. 6. Thus, any confidential information entered by the users of the *Coueignoux* system may not be published without the authorization from the user entering the information. Col. 6. The Examiner stated that, "One having ordinary skill in the art would have found it motivated to utilize such a combination in order to enhance security, thereby ensuring that the response is authorized or signed by the user." Non-Final Office Action, p. 2.

As argued by Applicant in its previous response, the motivation asserted by the Examiner is neither found explicitly in the references nor suggested to one of ordinary skill in the art. Non-Final Response, pp. 8-9. Because *Lang* already discusses security measures,

both for ensuring the reliability of the reputation information and for ensuring the authorization that a client has before accessing the reputation information, there is no explicit suggestion that an additional security measure of requiring an authorization by the party for which the reputation information is based, would be beneficial.

One of ordinary skill in the art would also not implicitly be motivated to combine *Lang* with *Coueignoux* either based on the teachings of those references or based on what those teachings might suggest in the knowledge generally available in the art. *Lang* teaches a repository for reputation information on a party that may be accessed by clients for obtaining this reputation information. [0005]. The purpose is to provide a reputation service where clients can have access to reputation information on certain parties. *Lang* describes security measures for ensuring that only authorized clients can access some reputation information. *Lang* also describes security measures for ensuring the accuracy and reliability of the information that the reputation information is based on. One of ordinary skill in the art would not be motivated to combine this *Lang* reputation system, with an additional security measure from *Coueignoux* that would require the reputation party to give authorization for the reputation information to be released to the requesting clients of *Lang*. One of ordinary skill in the art would easily recognize that this type of authorization, as described in *Coueignoux*, does not operate to enhance the security of the *Lang* system.

For example, *Lang* does not suggest that the reputation party enters its own reputation information. In *Coueignoux*, it is the party entering the information into the system that gives or withholds the authorization to make the information public. Thus, the security measure of allowing the user to safeguard his or her confidential information is a logical measure within the *Coueignoux* system. However, reputation information, which is the type of information dealt with in *Lang*, would not appear to be very reliable if it was the reputation party that enters the information. *Lang* suggests that a reputation party may be assigned the "liar" category for poor reputation for truthfulness. [0038]. One of ordinary skill in the art would easily recognize that a reputation party would hardly enter that he or she is a liar into a reputation service that may be accessed by clients wanting to obtain information on that party's reputation. Thus, one of ordinary skill in the art would never consider combining the teachings of *Lang* with *Coueignoux*. Applicant asserts that the Examiner's claimed

motivation is inconsistent with the teachings ***and suggestions*** given by the cited references and, as such, the combination of *Lang* and *Coueignoux* is improper.

B. Non-Analogous Art

In addition to the arguments expressed above, one of ordinary skill in the art would not combine any of the elements found in *Couiegnoux* with *Lang*. In order to rely on a reference as basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992); MPEP § 2141.01(a). As stated above, *Lang* and the claimed invention deal with reputation services. In a reputation service, the reputation information is generated by entities other than the party on whom the reputation information is based.

In contrast, *Coueignoux* is an information gathering service that gathers information directly from a party through scripts transmitted to the party's computer. The information gathered from the party in *Coueignoux* has nothing to do with that party's reputation. In fact, reputation information supplied from the party about whom the reputation information is directed would be inherently unreliable. Moreover, the manner in which the information is collected is completely different. Therefore, *Coueignoux* is not within the same endeavor as the claimed invention. Furthermore, as noted above, the authorization requirement that the Examiner has taken from *Coueignoux* concerns protections of confidential and private information entered by a party and has nothing to do with either reputation information or security of that reputation information, as the Examiner is attempting to assert. Therefore, the teachings of *Coueignoux* are also not reasonably pertinent to the particular problem that the claimed invention is concerned. As such, there can be no proper motivation to combine *Couiegnoux* with the teachings of *Lang*. M.P.E.P. § 2143.01; *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Without the features combined from *Couiegnoux*, *Lang* does not teach or suggest each and every limitation of independent claims 1, 9, and 15. Therefore, claims 1, 9, and 15 are patentable over *Lang* and/or *Couiegnoux*. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejections of record.

Dependent claims 2 – 8, 10 – 14, and 16 – 20 each depend either directly or indirectly from one of base claims 1, 9, and 15, respectfully, and, thus, inherit each and every limitation of their respective base claim. Therefore, because of their dependency, claims 2 – 8, 10 – 14, and 16 – 20 teach limitations not disclosed or suggested by *Lang* and/or *Couiegnoux*. Applicant, thus, asserts that claims 1 – 20 are patentable over the § 103(a) rejections of record and respectfully requests the Examiner to withdraw same.

C. Schuba *and* Lambert

The Examiner admits that *Schuba* and *Lambert* were not considered part of the rejection, but then states that *Schuba* and *Lambert,* when considered as a whole, make the claimed invention obvious to one of ordinary skill in the art. However, as noted above, in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992); M.P.E.P. § 2141.01(a). Neither *Schuba* nor *Lambert* is nonanalogous to the claimed invention.

The claimed invention deals, in general, with a reputation authority for electronically storing reputation information relating to a user, as disclosed in claim 1. *Schuba* is a method for authorizing remote transactions in which the user authorizes the package of information to be sent to the remote transaction authorization authority. [0005] – [0009]. *Schuba* was specifically intended for wireless devices in which it would be disadvantageous to transfer a large amount of data for transaction authorization over the wireless network. [0003] – [0004]. Thus, the underlying objects of each invention are completely different. Furthermore, the Examiner did not address Applicant's assertion that *Schuba* is nonanalogous to the claimed invention.

Lambert is a computer peripheral for transmitting security information, such as biometrics, along with information in order to complete a remote transaction. Col. 15. The object and underlying function of each invention are completely different. As explained above, the vast differences in the claimed invention and *Lambert* make them nonanalogous art. Therefore, *Lang* and *Lambert* also cannot be properly combined under 35 U.S.C. §

103(a). Furthermore, the Examiner did not address Applicant's assertion that *Lambert* is nonanalogous to the claimed invention.

In *Wang Laboratories, Inc., v. Toshiba Corp.,* the Federal Circuit held that an invention directed to a single in-line memory module (SIMM) for installation on a printed circuit board for use in personal computers was not analogous to a SIMM for an industrial controller. Even though both inventions concerned SIMM modules in general, because their application and makeup were different, the cited reference was held to be nonanalogous. 993 F.2d 858 (Fed. Cir. 1993). In the present case, the reference and the claimed invention are even more different that the SIMMs discussed in *Wang*. In the present case, both inventions involve computers at some level; however, that is where the similarity ends. The underlying functions of each feature are completely different. The Examiner is simply picking a feature from nonanalogous references in order to provide missing claim limitations. Therefore, neither *Shuba* nor *Lambert* can properly be combined with *Lang* under 35 U.S.C. § 103.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10007376-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482737484US, in an envelope addressed to: MS AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: March 23, 2005

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Respectfully submitted,

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